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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. |
|-----------------|-------------|----------------------|---------------------|
| 08/853,007 | 05/08/97 | CHI-YA CHENG | J 7936 |

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| EXAMINER | |
|-------------|--------------|
| YILDIRIM, B | |
| ART UNIT | PAPER NUMBER |
| | 1764 |

DATE MAILED: 07/07/98

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

08/853,007

Applicant(s)

Cheng et al.

Examiner

Bekir L. Yildirim

Group Art Unit

1764



☐ Responsive to communication(s) filed on _____.

☐ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-10 is/are pending in the application.

Of the above, claim(s) _____ is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 1-10 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____.

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☐ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 2&3

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1-10 are rejected under 35 U.S.C. 102(b) as being anticipated by Kushnerick et al. (USP 4,992,606).

The reference teaches the same process with the same MCM-22 catalyst having the same diffraction pattern, under the same conditions, thus anticipates the claimed invention.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.

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4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

5. Claims 1-10 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kushnerick et al. (USP 4,992,606).

The reference teaches the same process with the same MCM-22 catalyst having the same diffraction pattern, under the same conditions (see claims). The reference catalyst may optionally contain a binder to increase the crush-strength thereof (col. 9, lines 30-37; col. 10, lines 41-42).

A distinction may be made between the two catalyst compositions in that the reference catalyst may comprise a binder, while the instant claims recite a binder-free catalyst. The invention as a whole however would have been obvious to one having ordinary skill in the art since the artisan equipped with the reference teachings would select either one of two alternatives, i.e. with and without binder in the reference. Furthermore the omission of means (the binder) together with its function (enhancement of crush strength) would not involve an invention. See Ex parte CRIGER, 125 USPQ 448 (BdPatApp&Int 1960) or In re Pedley, 41 CCPA 868, 101 USPQ 286, 1954 C.D. 163, 686 O.G. 5. 212 F.2d 199.

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Bekir L. Yildirim whose telephone number is (703) 308-3586.



Bekir L. Yildirim
Primary Examiner
A.U. 1764

B.L.Y.
July 6, 1998